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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,202	12/10/2001	Brian E. Springett	D/99720C	7306
7590	02/27/2003			
Patent Documentation Center Xerox Corporation Xerox Square, 20th Floor 100 Clinton Ave. S., Rochester, NY 14644			EXAMINER TRAN, HUAN HUU	
		ART UNIT 2861	PAPER NUMBER	
DATE MAILED: 02/27/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

AIC

<b>Office Action Summary</b>	Application N .	Applicant(s)
	10/010,202	SPRINGETT ET AL.
	Examiner	Art Unit
	Huan H. Tran	2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 February 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,4-6 and 8-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,4-6 and 8-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 2, 4-6, 8-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Franke (WO 97/21867) cited in the IDS dated 12/01/01).

Franke discloses a transfer sheet including a carrier sheet; a one- or multi-colored pattern printed on the carrier sheet using a digitally controlled color printer; a transparent or white-pigmented layer printed configuratively by silk screen printing on the pattern; a layer of heat activatable, thermoplastic polymeric glue layer positioned over at least said white-pigmented layer or the transparent or white-pigmented layer includes an adhesive (see, for example, the paragraph bridging pages 4 and 5 of the specification of the present application describing WO 97/21867).

It should be noted that it is well settled that "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, the processes used to deposit the various layers are not given patentable weight.

***Response to Arguments***

3. Applicant's arguments filed on 02/19/03 have been fully considered but they are not persuasive. Argument was made that Franke may not properly be cited as a reference against the Applicants' claims because the claims

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presently before the PTO disclose a process limitation that is not disclosed in Franke. Specifically, it was argued that where it is not possible to define the characteristics which make a claimed article inventive except by referring to the process by which the article is made, Applicant is permitted to so claim the article, but is limited in his protection to articles produced by the method referred to in the claims, citing *Atlantic Thermoplastics v. Faytex*, 970 F.2d 834; 23 USPQ2d 1481 (Fed. Cir., 1992). This argument is not persuasive because the cited case law is applicable in an infringement analysis rather than in a determination for patentability. As noted in the rejection above the patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113 regarding product-by-process claims.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huan H. Tran whose telephone number

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is (703) 308-0749. The examiner can normally be reached on M-F with alternate Friday off, from 7:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Fuller can be reached on (703) 308-0079. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-3421 for regular communications and (703) 308-3421 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1749.



Huan H. Tran  
Primary Examiner  
Art Unit 2861

hht  
February 25, 2003